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# SUPREME COURT OF THE UNITED STATES

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**OCTOBER TERM, 1941.**

**No. .....**

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**WALGREEN CO., and**
**ALLIED ELECTRIC PRODUCTS, INC.,**
*Petitioners,*

**vs.**

**GEORGE H. GLADE, JR.,**
*Respondent.*

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**PETITION OF WALGREEN CO. AND ALLIED ELECTRIC PRODUCTS, INC., FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.**

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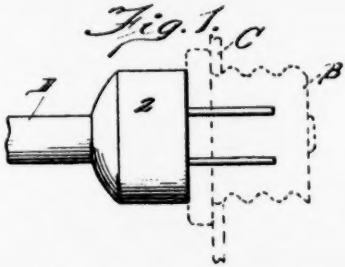
*To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:*

Your Petitioners, Walgreen Co. and Allied Electric Products, Inc., respectfully pray for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit to review the judgment of that Court entered on the 22nd day of July, 1941 (Petition for Rehearing denied September 12, 1941). A transcript of the record in this case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the rules of this Court.

**Summary and Short Statement of the Matter Involved.**

1. Respondent, George H. Glade, Jr., is the owner of Martin patent No. 2,115,642, granted April 26, 1938, for an alleged invention in "ELECTRICAL CONDUCTOR TERMINAL CAP" (the familiar so-called electric plug commonly inserted into a wall socket for connecting lamps or other electric appliances into an electric circuit). To make plain the type of plug in question, the showing of the same in Figure 1 of the Martin patent is reproduced below.)




2. Petitioner, Allied Electric Products, Inc., is a New Jersey corporation with its factory located at Irvington, New Jersey, and is engaged, *inter alia,* in the manufacture of electric plugs. Petitioner, Walgreen Co., is an Illinois corporation, having an established place of business in Chicago, Illinois, and owning and operating a chain of drug stores located in various cities throughout the United States, including Illinois, and through them sells, *inter alia,* electrical appliances provided with electric plugs manufactured by Allied.

3. The accused plugs are of a type commonly known as "manufacturer's plugs." This means that the plugs are of a type in which the unassembled parts of the plug (the plug body and two contact blades for each plug) are sold to manufacturers of electrical appliances. The lat-

ter assemble these parts with an electric conductor cord, in applying the plugs to the electrical appliances which such manufacturers make.

4. Respondent instituted a suit against Petitioner, Walgreen, on Claims 1, 5, 7, 8, 9, 10 and 11 of the Martin patent in the United States District Court for the Northern District of Illinois, Eastern Division, charging infringement by reason of the sale by Walgreen of electrical appliances having thereon the accused plugs. Petitioner, Allied, intervened as a party defendant and assumed the defense of the case.*

5. The Martin patent discloses (R. 318) an electric plug of familiar and well-known general form. The particular plug shown in the patent consists of a plug body of insulating material, into one side of which extends a conductor cord and from the opposite side of which projects a pair of blades or prongs for insertion into the usual socket. Each of the blades has on its butt end portion a series of laterally projecting barbs which dig into the side walls of preformed holes in the plug body and thus hold the blades in place when the blades are jammed into the holes. The conductor cord is led through a central hole in the plug body, the ends of the two wires of the cord being bent apart, bared, and led to the holes which receive the blades, where they are wedged between the blades and the hole walls. Electrical contact is thus secured between the bare ends of the wires and the respective blades.

6. Respondent asserted, and the Court of Appeals below held (R. 674) that the patentee, Martin, had accomplished in a three-part plug (two blades and a plug body)

* Petitioner, Allied, after intervening, counterclaimed for infringement by Glade of its McCormick patent No. 1,961,235, but no review is here sought of the judgment of the Court below invalidating said McCormick patent.

what had theretofore required five parts (the same two blades and a plug body, plus two screw parts for clamping the wires to the respective blades). But having arrived at this conclusion, the Court of Appeals below upheld all of the Martin patent claims in suit, *despite the fact that, as stated even in the Court's own opinion, Claims 1, 5, 7 and 11 make no reference to any particular form of wire attachment to the blades and relate solely to means for mounting the blades in the plug body structures which they define. In other words, the Court of Appeals below validated Martin's group of broad claims on the ground that Martin was the first to produce a three-part plug, as contrasted with the five-element plugs of the prior art, despite the fact that this particular group of claims is broad enough to, and was intended to, cover a five-part plug as well as a three-part plug.*

7. It is to be observed that although the Court of Appeals below did make some grouping of the Martin claims on the basis of scope, which, as pointed out above, it subsequently failed to adhere to in its decision, the District Court did not in its opinion make any distinction between various ones of the Martin claims. In other words, the District Court simply found that there was invention present and did not analyze the individual claims to determine whether or not each or any of them actually defined that invention. Consequently, there is no concurrence of opinion below of invention in the several claims in issue. *Altoona Publix Theaters* v. *American Tri-Ergon Corp.*, 294 U. S. 477 at p. 480.

8. Of the group of broad claims of the Martin patent noted above, Claim 5 was selected by the Court of Appeals below as typical (see opinion R. p. 674). It does not differentiate even in words, much less in substance, from the prior art. For example, even in the old 1912

British patent of Day, No. 14,306 (R. 597), is shown a plug comprising a plug body with two prongs jammed into preformed holes in it, but in which the wires enter *directly* into these same holes rather than passing circuitously first through a central hole and then into the blade-receiving holes as shown by Martin. Although Martin's Claim 5 is wholly *silent* as to any central hole for entry of the wires, and obviously broad enough to embrace the British patent structure of 1912, the Court of Appeals below sustained this claim by *reading into it by implication* language which plainly is not there. *The Court below thus read into the claim, in order to save it from the prior art, a limitation which it lacked. Such a mode of construction for patent claims is in direct conflict with the previous decisions of this Court.*

9. It is characteristic of all of the Martin claims in suit that they call for *two* blades as distinguished from one or three, or any other number, and this despite the fact that all of these various numbers of blades are commonly used in the art. The number of blades on the plug depends merely upon the number of wires in the electric circuit in which it is employed. It is thus apparent that the assertion on behalf of Martin that he invented a new three-part plug proceeds upon a false premise, for it entails the arbitrary inclusion of *two* blades as contrasted with any other number. Even taking Respondent's contentions at face value, namely, that Martin was the first to fasten both a connector blade and a wire to an insulating base simply by a frictional wedging of the same into a hole, still his resulting combination comprised merely two parts (viz: a blade and a plug body), and *not* three parts (*i.e., two* blades and a plug body). Respondent has made no showing that the inclusion of the extra blade in the claimed combination is anything but superfluous,

wherefore all of the Martin claims set forth a mere unpatentable *aggregation.*

10. The Court of Appeals below made no attempt in its opinion to justify its validation of the plainly aggregative Martin claims over such prior patents as British patent to Cook, No. 291,583 (R. 653), which plainly disclosed the basic two-part combination that Martin later utilized. The aggregative character of the Martin claims thus not only renders them defective as a matter of law, but obscures the true pertinency of the prior art.

11. Prior to the issuance of the injunction in this case, Petitioner, Allied, was the largest single manufacturer of manufacturer's type electric plugs in the United States, supplying approximately one-third of such plugs used during the two year period between issuance of the Martin patent and granting of the injunction. *During the period noted, Allied sold more than 30,000,000 such plugs* (see affidavit herewith). *The granting of an injunction on the Martin patent in this case has caused such a serious shortage in manufacturer's type plugs that purchasers have had actually to curtail their sales of electrical appliances. Because of the shortage of manufacturer's plugs, former purchasers of the same have had to use plugs of other types costing as much as four hundred per cent more. The injunction in this case thus affects such a large volume of business as to be vital to the industry as a whole, wherefore this petition for a writ of certiorari has been presented.*

**Reasons Relied Upon for the Grant of a Writ of Certiorari.**

The discretionary power of this Court is invoked upon the following grounds:

1. Because the Court of Appeals for the Seventh Circuit has sustained as valid a patent against a defendant (Petitioner Allied) which was theretofore the largest supplier of manufacturer's type electric plugs in the United States, *whereby the users of such plugs have been deprived of substantially one-third of their previous supply (at least 15,000,000 plugs per year) with the result that an acute shortage of plugs has ensued, wherefore the issues presented between the parties in this cause are vital to the industry as a whole.*

2. Because the Court of Appeals for the Seventh Circuit has, in order to sustain a patent claim, read into such claim *by implication* an element which it does *not* in fact contain, *though the inclusion of such element was requisite to distinguish the claim even in words, much less in substance, from the prior art.* This holding is untenable because it is in direct conflict with the applicable decisions of this Court.

3. Because the Court of Appeals for the Seventh Circuit has *sustained as valid certain patent claims upon the ground that the patentee had invented a certain three-part plug (as distinguished from prior art plugs composed of five parts) despite the fact that the very claims in question are broad enough to, and were intended to, cover a five-part plug;* wherefore said holding is untenable, being in direct conflict with the applicable decisions of this Court.

4. Because the Court of Appeals for the Seventh Circuit has sustained as valid a patent for an alleged combination which is *unpatentably aggregational on its face,* thereby rendering a decision which is untenable because

it is in direct conflict with the applicable decisions of this Court.

WHEREFORE, your petitioners pray that a writ of certiorari issue out of and under the seal of this Court, directed to the United States Court of Appeals for the Seventh Judicial Circuit, commanding said Court to certify and send to this Court, on a date to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, as to the questions herein presented, as well as to the questions of anticipation and invention, and that the judgment of the Court of Appeals be reversed insofar as it found validity for Martin patent No. 2,115,642, and that petitioners may be granted such other and further relief as may seem proper.

Respectfully submitted,

C. PAUL PARKER,
*Counsel for Petitioners.*

**Affidavit in Support of Petition for Writ of Certiorari.**

County of Essex, }
State of New Jersey. } ss.

Nathan Chirelstein, being duly sworn, deposes and says that he is of legal age, and is the President of Petitioner, Allied Electric Products, Inc.;

That his company made and sold more than 30,000,000 of the accused plugs in a period of approximately two years between the issuance of the Martin patent and the stoppage of such manufacture by injunction in this cause; that during such period his company was the largest producer of manufacturer's type plugs in the United States, the output of his company representing substantially one-third the entire supply of manufacturer's plugs in the United States during that time; that since the issuance of the injunction in this case, former purchasers of the accused plugs have reported an acute shortage of manufacturer's type plugs and have had to curtail their sales of electrical appliances in consequence of such shortage; that since the issuance of said injunction some manufacturers of electrical appliances have had to use plugs, other than manufacturer's type plugs, costing substantially four hundred per cent more than manufacturer's plugs did prior to the issuance of said injunction.

Nathan Chirelstein.

Subscribed and sworn to before me this ..... day of ....., 1941.

.....

*Notary Public.*

(Seal)

## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

### Opinions of the Courts Below.

The opinion of the District Court was rendered orally at the conclusion of the trial, and is reported in 48 U. S. P. Q. 59, and will also be found beginning at page 286 of the record.

The opinion of the Court of Appeals for the Seventh Circuit is reported in 122 F. (2d) 306, and will also be found beginning at page 674 of the record.

### Jurisdiction.

The grounds of jurisdiction are:

1. The date of the judgment to be reviewed is July 22, 1941; Petition for Rehearing denied September 12, 1941.
2. The judgment was rendered in a civil action brought under the patent statutes to determine the issues of validity and infringement of Letters Patent of invention.
3. The statute under which jurisdiction is invoked is 240(a) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.
4. Cases believed to sustain the jurisdiction are:

*Mackay Radio & Telegraph Company* v. *Radio Corporation of America,* 306 U. S. 86.

*Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 305 U. S. 47.

*Paramount Publix Theaters* v. *American Tri-Ergon Corp.,* 294 U. S. 477.

## Statement.

The facts are sufficiently stated in the petition.

## Specification of Errors.

The errors which Petitioners will urge, if the petition for certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. in sustaining Martin patent No. 2,115,642 as valid.
2. in reading into Martin Claim 5, by implication, a limitation which it does not contain in order to save it from anticipation by the prior art.
3. in failing to invalidate Martin Claims 1, 5, 7 and 11 as being broader than even the alleged combination which the Court of Appeals found to be inventive.
4. in failing to invalidate Claims 1, 5, 7, 8, 9, 10 and 11 of the Martin patent as wanting in invention, and as being for unpatentable aggregations.

## Summary of Argument.

The points of argument follow the reasons relied upon for the grant of a writ of certiorari, and are stated on page 7 of the petition, as well as in the index hereto. For the sake of brevity, they are omitted at this point.

## POINT 1.

**The Court of Appeals for the Seventh Circuit has sustained as valid a patent against a defendant (Petitioner Allied) which was theretofore the largest supplier of manufacturer's type electric plugs in the United States, whereby the users of such plugs have been deprived of substantially one-third of their previous supply (at least 15,000,000 plugs per year) with the result that an acute shortage of plugs has ensued, wherefore the issues presented between the parties in this cause are vital to the industry as a whole.**

The extremely large volume of Petitioner Allied's business, prior to the grant of injunction in this case, has caused such injunction to affect the entire industry throughout the United States.

An acute shortage of manufacturer's type plugs has resulted from the grant of injunction in this case and has actually caused the curtailment of the production of electrical appliances in general simply because of inability to procure attachment plugs for them. These circumstances render the present case of peculiar importance to manufacturers throughout the country.

Since this single case does directly affect not only the entire plug industry, but also the related industry of electrical appliance manufacture, certiorari should here be granted:

*Mackay Radio & Telegraph Company* v. *Radio Corporation of America*, 306 U. S. 86.

*Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 47.

*Paramount Publix Theaters* v. *American Tri-Ergon Corp.*, 294 U. S. 477.

## POINT 2.

**The Court of Appeals for the Seventh Circuit has, in order to sustain a patent claim, read into such claim by implication an element which it does not in fact contain, though the inclusion of such element was requisite to distinguish the claim even in words, much less in substance, from the prior art. This holding is untenable because it is in direct conflict with the applicable decisions of this Court.**

The Court of Appeals below selected Claim 5 of the Martin patent as typical of the broad group of claims in suit from that patent (see opinion R. 674). It is apparent upon its face that Claim 5 is a very broad claim.* As construed by the Court of Appeals it is broad enough to cover any plug in which the blades are mounted by driving them into holes in a plug body. Obviously, it is doubtful at the outset that there could, at this late date, be any invention in such a concept.

The Court of Appeals below said in its opinion as to Claim 5:

> "With respect to Claim 5 of the Martin patent, defendants contend that it does not specify a central bore in the plug body. This is quite true, but we do not understand that each claim must describe every feature set forth in the other claims and in the specification, and in construing any claim it is to be done in view of the device of the character described in the specification . . . The reference to the specification is not for the purpose of broadening the claims, but it is only permitted for the purpose of explaining them, and to give a clear perspective of the de-

---

* Claim 5 reads: "An electrical fitting comprising a body of non-frangible insulating material having a face and two spaced holes extending inwardly from the face, and metallic members having prongs forced into the holes, the sides of the prongs having laterally extending projections which engage the walls of the holes and resist removal."

> vice to which the claim is to be applied. Hence, we think claim 5 does contemplate a central bore in the plug body because it is ever-present in the device described in the specification."

*The Court of Appeals below thus, by its construction of this broad claim, read into it an element which it does not contain.* Furthermore, *the inclusion of that element was vital to save the claim from anticipation* for, without it, the claim reads squarely on even such an old device as that shown in the 1912 British patent of Day, No. 14,306 (R. 597). Even if the claim had included the element in question it would still have lacked invention over the art, for it was notoriously old to provide a plug body in which the electric cord entered through a central bore. *In any event, the claim is obviously and admittedly silent as to the element in question which would be necessary to distinguish it from the prior art even in words, much less in substance.*

This Court has repeatedly and expressly condemned precisely the type of claim interpretation in which the Court of Appeals below indulged in order to save Claim 5: *McCarty* v. *Lehigh R. Co.*, 160 U. S. 110, 116; *White* v. *Dunbar*, 119 U. S. 47, 52; *Minerals Separation* v. *Butte & S. Min. Co.*, 250 U. S. 336, 347. In the *Lehigh* case just cited, this Court said:

> "It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement."

*In other words, the Court of Appeals below has, in the present case, done precisely and exactly what this Court has explicitly said it knows of no principle of law to support.*

## POINT 3.

**The Court of Appeals for the Seventh Circuit has sustained as valid certain patent claims upon the ground that the patentee has invented a certain three-part plug (as distinguished from prior art plugs composed of five parts) despite the fact that the very claims in question are broad enough to, and were intended to, cover a five-part plug; wherefore said holding is untenable, being in direct conflict with the applicable decisions of this Court.**

As the major and only basis expressed in the opinion of the Court of Appeals below for finding patentable subject matter in the Martin patent, the Court below said:

> "In other words, he produces the same result in a more efficient and facile manner by making *three* of those old elements accomplish the same result as *five* or more had theretofore done."

The "three" parts of the Martin plug in question are (one) a plug body, and (two and three) a pair of blades driven into recesses in the plug body in such manner as not only to wedge the blades themselves in place, but also to hold the ends of the wires in contact with the blades.

The "five" parts of the prior art plugs (see, for example, British patent No. 14,306 of Day at R. 597 and discussed in the opinion of the Court of Appeals below) are the same three elements, namely, (one) a plug body, and (two and three) a pair of blades driven into recesses in the plug body, *plus* (four and five) two screw parts for attaching the wires to the blades. In other words, it is the addition of two screw parts for attaching the wires to the blades which makes the total number of parts add up to five instead of three.

But the broad group of claims of Martin, which the Court below sustained along with a narrower group of claims, is not limited to three parts but is, instead, broad

enough to cover precisely the five-part structure of the prior art in which two additional screw parts are used to attach the wires to the blades. As to this, the Court of Appeals below itself has said in its opinion:

> "In discussing the claims of this patent, defendants classify them into two groups, and we shall so treat them. They classify Claims 1, 5, 7 and 11 as the first group *because they make no reference to any particular form of wire attachment to the blades, and relate solely to means for mounting the blades in the plug body structures which they define.* They select Claim 5 as typical of this group."

Since the group of broad claims noted above (Claims 1, 5, 7 and 11) are *not* limited to any particular form of wire attachment to the blades, they are obviously broad enough to cover the five-part arrangement of the prior art in which extra attachment screws are provided for that purpose. Further evidence, if any be needed, that this broad group of Martin claims is intended to, and does, cover a five-part plug (*i.e.*, one having, in addition to the plug body and pair of blades, a pair of screw parts for wire attachment), is afforded by the Benander patent No. 2,099,555 of record (R. 573) and referred to in the opinion of the Court of Appeals below. As noted in the opinion below, Martin was in interference in the Patent Office with Benander as to Martin's Claim 5. Therefore, Claim 5 had to be, and was, construed by the Patent Office as broad enough to cover the Benander plug. But Benander shows a *five-part* plug with screws for attaching the wires to the blades and nowhere even suggests a three-part plug.

It will thus be seen that the Court of Appeals below has validated Martin's group of broad claims on the ground that Martin was the first to produce a three-element plug as contrasted with the five-element plugs of the prior art, despite the fact that this particular group of claims from the Martin patent is broad enough to, and

is intended to, cover a five-element plug, as well as a three-element plug. Such a disregard of the scope of claims of a patent is in plain contravention to the applicable decisions of this Court: *White* v. *Dunbar*, 119 U. S. 47, 52; and *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U. S. 364, 369.

## POINT 4.

**The Court of Appeals for the Seventh Circuit has sustained as valid a patent for an alleged invention which is unpatentably aggregational on its face, thereby rendering a decision which is untenable because it is in direct conflict with the applicable decisions of this Court.**

As pointed out above, the Court of Appeals below predicated its finding of invention in the Martin patent on the ground that they believed Martin to be the first to have produced a so-called "three-element plug," that is to say, a plug consisting solely of a plug body and two blades, the blades being so fashioned that they retain themselves in place upon being driven into the plug body, and also at the same time wedge the wire ends in place so as to secure attachment of the wires to the blades. Even assuming, for the sake of argument, that Martin was the first to produce a three-element plug, as distinguished from a five-element type which was admittedly old in the prior art, it is our contention that this analysis in numbering is arbitrary and proceeds on a false premise; that in such event Martin's real contribution was a two-part (not a three-part) structure, namely, a blade and a base for supporting the blade and attaching a wire to it; *and that having claimed a three-part combination rather than his two-part combination, his patent is void as a matter of law.* More specifically, respondent in effect asserts, and the Court of Appeals below has agreed, that he was the first

to drive a connector blade into a preformed hole in an insulator base (to hold the blade in place on the base) and at the same time wedge the bare end of a wire in the hole in the base by the blade itself (to thereby fasten the wire to the blade without the use of a separate screw or the like for the purpose).

That being the case, it is clear that there are only two, not three, parts in the combination, viz: a blade and an insulating support or base. *But Martin did not claim that.* He arbitrarily included "two" blades in his aggregative claims, thereby making a total of three parts. We say the number of blades is "arbitrary" because the art is replete with instances of plugs of this type in which one, two, three, four and more blades are used. The number is determined simply and solely by the number of wires in the circuit to which the plug is attached, *not* by any new coaction of the parts in the plug which makes two blades significant as compared to any other number.

If petitioners made a three-blade Martin plug, respondent would be the first to cry "infringer" and "mere colorable evasion," and yet the Court of Appeals below has permitted these arbitrarily limited and therefore aggregational claims to stand. The point is important not only because the Martin claims are bad as a matter of law, including as they do an arbitrary aggregation of parts which does not constitute the true invention if any, but also, because of their inclusion, respondent has succeeded in obscuring the true pertinence of the prior art.

Patent claims aggregatively adding to a combination arbitrarily selected additional parts have been frequently condemned in the decisions of this Court: *Lincoln Engineering Co.* v. *Stewart Warner Corp.*, 303 U. S. 545, 549; *Bassick Mfg. Co.* v. *Hollingshead Co.*, 298 U. S. 415, 425.

**Conclusion.**

Wherefore, petitioners earnestly pray that the petition for writ of certiorari be granted, the case be reviewed, and the decree of the Court of Appeals for the Seventh Circuit finding validity for Martin patent No. 2,115,642 be reversed.

Respectfully submitted,

C. PAUL PARKER,
*Counsel for Petitioners.*

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NOV 26 1941
CHARLES ELMORE CROPLEY
CLERK

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1941.

## No. 737

WALGREEN CO., AND ALLIED ELECTRIC PRODUCTS, INC.,

*Petitioners,*

*vs.*

GEORGE H. GLADE, JR.,

*Respondent.*

**RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.**

GEORGE BAYARD JONES,
*Counsel for Respondent.*

GEORGE A. CHRITTON,
RUSSELL WILES,
CHRITTON, WILES, DAVIES & HIRSCHL,
*Of Counsel.*

Chicago, November 22, 1941.

THE GUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1941.

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No. .....

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WALGREEN CO., AND ALLIED ELECTRIC PRODUCTS, INC.,

*Petitioners,*

*vs.*

GEORGE H. GLADE, JR.,

*Respondent.*

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## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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*To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:*

### INTRODUCTORY STATEMENT.

This case, in the United States Circuit Court of Appeals for the Seventh Circuit, involved the usual issues of validity and infringement of Martin Patent 2,115,642 relating to Electrical Conductor Terminal Caps. The Court of Appeals (R. 674) held the patent valid and infringed, affirming the judgment of the District Court (R. 286) and subsequently denied a Petition for Rehearing (R. 683).

No conflict of decisions in different Circuit Court of Appeals is involved.

A brief chronological history of the invention and of its appropriation by Petitioner is as follows:

Martin, the inventor, while in the employ of Glade Manufacturing Company of Chicago, a partnership, assigned his invention to George H. Glade, Jr., one of the two partners, the other being his father, George H. Glade. The company caused a patent application to be filed August 5, 1929 and conducted the prosecution of it.

In 1931 the invention was put on the market by Glade Manufacturing Company (R. 88). In March 1933 an interference was declared by the Patent Office with an application of Benander whose assignee was General Electric Co. (R. 250). During 1934, Respondent, Glade, and his father had been buying certain products from Petitioner, Allied Electric Company of Irvington, New Jersey. In 1935 Glade, Sr. showed the Martin plug to the president of Allied Electric Company, the Petitioner (R. 74, 75). Later in the same year the Allied Company began the sale of the infringing plugs complained of.

On February 4, 1937 the Board of Appeals in the Patent Office awarded priority of invention to Martin in said interference, and against the General Electric Company. Said company shortly thereafter took a license under said application (R. 72, 83). Other companies took lisences subsequently (R. 72). In September 1937, Petitioner advertised that it had sold many million of the rival plugs. The Martin patent had not yet been granted at that date, due to the final steps taken in the prosecution of the application and necessitated by the excessively long priority contest in the Patent Office. Before the issuance of the Martin patent, the Respondent, of course, had no redress for the competition caused by the sale of millions of substantially identical rival devices. However, said Martin patent finally issued April 26, 1938 to Glade, Jr., the Respondent, after having been in the Patent Office almost nine years.

The Glades, after trying to dissuade Allied Company

from continuing its infringement (R. 75) filed suit in October 1939 against a customer of Allied in Chicago, *i. e.*, Walgreen Company. About a month prior thereto, September 27, 1939, following the Respondent's attempts to dissuade Allied Company from infringing, the latter bought an earlier patent than the Martin patent, *i. e.*, McCormick 1,961,235, under which it sought to justify its infringement. This patent was made the basis of a counterclaim but the claims thereof were held invalid both by the District Court and the Court of Appeals, and no review is sought by Petitioners of the judgment of the court below in invalidating said McCormick patent, as explained at the bottom of page 3 of the Petition.

## SUMMARY OF ARGUMENT.

Reference may be had to the index for this summary.

## POINTS AND AUTHORITIES.

These are incorporated in the argument and hence, in the interests of brevity, are not duplicated here.

## ARGUMENT.

### I.

The action below involved the usual issues of validity and infringement in a patent case, there being no conflict of decisions in different Circuit Courts of Appeals.

The Martin Patent 2,115,642, owned by the Plaintiff Glade, the Respondent, was involved for four years in the priority contest or interference in the Patent Office with a Benander application owned by the General Electric Company before it issued as a patent. The only unusual feature of this case is, therefore, that the patent in suit was subjected to an exceptionally close scrutiny by the Patent Office and by the opposing party before said patent was granted.

In the District Court of Northern Illinois, Eastern Division, Judge John P. Barnes, after a full hearing lasting several days, held all of the claims in suit valid and infringed (R. 286-289, inclusive).

Subsequently the Court of Appeals for the Seventh Circuit (Judges Evans, Sparks and Kerner) affirmed the decision of the District Court in an exhaustive and unanimous opinion (R. 674-682, inclusive), in which substantially all the points now presented in the Petition for Writ of Certiorari were ruled on adversely, having been presented also to the Court of Appeals in a Petition for Rehearing.

It has long been the established practice of this Court to refuse to review issues as to invention and the validity of a patent under these circumstances.

Thus, in the case of *Continental Paper Bag Company* v. *Eastern Paper Bag Company*, 210 U. S. 405 (52 L. Ed.

1122, 1127), this Court, in an analogous situation, said at page 416:

> "The lower courts, therefore, found that the invention was a broad one, and that the machine used by the Continental Company was an infringement. And these were questions of fact upon which, both of the courts concurring, their findings will not be disturbed, unless clearly wrong. *Deslions* v. *La Compagnie Generale Transatlantique,* 210 U. S. 95, *ante,* 973, 38 Sup. Ct. Rep. 664."

Similarly, in the more recent case of *General Talking Pictures Corporation* v. *Western Electric Company, Inc., et al.,* 304 U. S. 175 (82 L. Ed. 1273, 1275) this Court said, at pages 178, 179:

> "There is nothing in the lower courts' decision on either of the added questions to warrant review here. Whether respondents acquiesced in the infringement and are estopped depends upon the facts. Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. * * * Moreover, the decision on that point rests on concurrent findings. *They are not to be disturbed unless plainly without support.* * * * *There is evidence to support them. Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues,* for as to them there is no conflict between decisions of circuit courts of appeals."

There is no conflict between or among Circuit Courts of Appeals as to the validity or infringement of the Martin patent in suit, since the litigation below was the first and is the only adjudication of this patent.

Under such circumstances it has long been the established policy of this Court to refuse to grant the writ of certiorari prayed for here. (Judicial Code, as amended, Sec. 240a, U. S. C. A. Title 28, Sec. 347, Rule 38 of the Rules of the United States Supreme Court, Par. 5, Secs. a, b and c.)

Thus, in the case of *Caroline M. Forsythe* v. *City of Hammond, et al.*, 166 U. S. 506 (41 L. Ed. 1095, 1098, 1099), this Court in reiterating a policy with respect to granting certiorari, even then long established, said, at pages 514 and 515:

> "* * * it is a power which will be sparingly exercised, and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more courts of appeals, or between courts of appeal and the courts of a state, or some matter affecting the interests of this nation in its internal or external relations, demands such exercise."

Similarly, in a later case, namely, *Clarence D. Keller et al.* v. *Adams-Campbell Company, Inc., et al.*, 264 U. S. 314, 68 L. Ed. 705 (1924), this Court, in an analogous patent case, said, at page 319:

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent."

## II.

### REPLY TO POINT 1 OF PETITIONER'S BRIEF.

This first ground (see p. 13 of Petitioner's brief) is based on the assertion that Petitioner was heretofore the largest manufacturer of a certain type of electric attachment plugs in the United States and that since the issuance of the injunction against Petitioner for infringement of Respondent's patent, the users of such plugs have been deprived of substantially one-third of their previous supply, resulting in an acute shortage, which is alleged to be detrimental to the industry as a whole and hence a matter of national concern. The Petitioner is unable to point to any part of the voluminous record, however, to establish

this allegation. The record does show that Respondent and Glade Manufacturing Company completed the commercial development of the attachment plug in issue and has had it on the market continuously ever since (R. 88 and Plaintiff's Exhibit 9). This attachment plug was disclosed to the president of the defendant company, Allied Electric Products, Inc. (the Petitioner), long before the patent issued (R. 75) and was copied in its essential features by the Petitioner and marketed in competition with Respondent's plug.

It is a matter of common knowledge that the recent defense program has greatly restricted the output of many manufacturers of non-essential products due to the enormous demand for certain metals, particularly copper and brass, resulting in priority rulings thereon. The attachment plug in issue consists of brass prongs held in a base of insulating material, as described more in detail on page 2 of the Petition. The lack of brass is primarily responsible for the difficulty now complained of by Petitioner, which shortage affects the Respondent as well.

A reversal of the decree of the Seventh Circuit Court of Appeals under which Petitioner would be permitted to resume manufacture of respondent's plug, would not free the Petitioner from priority restrictions and said Petitioner would be no more in a position to relieve the acute shortage of plugs than any other manufacturer needing large quantities of brass for electrical products. Such manufacture could have been continued, however, had Petitioner filed the requisite bond prior to the filing of its appeal (R. 304).

## III.

### REPLY TO POINT 2 OF PETITIONER'S BRIEF.

The allegation on page 14 of Petitioner's brief is, in substance, that the Court of Appeals read into claim 5 a limitation without which the claim would not distinguish from the prior art even in words, must less in substance, and that the court erred in so doing.

Claim 5 was one of the claims involved in the long priority contest in the Patent Office, and was awarded to Martin after a careful consideration of the prior art and against the opposition of General Electric Company, the award having been made first by the Examiner of Interferences and subsequently on appeal by the Board of Appeals (R. 216). An earlier decision of the Board of Appeals approved this claim as to patentability, before the priority issue was presented (Exhibit 23, R. 163).

When Petitioner, in its brief before the Seventh Circuit Court of Appeals made this same assertion with respect to the invalidity of claim 5, the Respondent pointed out in his brief that said claim 5 (printed at the bottom of page 14 of the Petition) distinguished from the prior art and particularly from the British Day Patent 14,306 of 1912 in stating that—

> "the sides of the prongs having laterally extending projections which *engage* the *walls* of the *holes* and resist removal."

The Court of Appeals recognized these distinctions between said claim and the prior Day patent, in the last two lines of its opinion, as found at the bottom of page 5 thereof (R. 678) stating also as to these two patents—

> "They not only differ as to details but also as to concepts."

It is true, as stated in substance by Petitioner, that the opinion, on page 8 thereof, states:

> "We think claim 5 does contemplate a central bore

> in the plug body because it is ever present in the device described in the specification."

Nevertheless, it will be noted that the court had previously stated in substance that this claim was patentable over the prior art, and hence the subsequent discussion on page 8 (R. 681) relates to what may be called matters of form. The conclusion we draw is that it is immaterial whether claim 5 should include express reference to the central bore or not, as a central bore *per se* is shown in most of the references relied on by the Defendant, the Petitioner.

It is unnecessary, therefore, to discuss the Supreme Court cases which the Petitioner relies on as disapproving of reading into a claim "an element which it does not contain." As previously stated, the claim is clearly valid without any added element, if in fact an opening can properly be said to be an "element" in the sense of something tangible.

## IV.

### REPLY TO POINT 3 OF PETITIONER'S BRIEF.

This heading identifies a discussion as to simplification from a five part to a three part plug.

Petitioner has overstated the case in asserting on page 16—

> "As the major and *only* basis expressed in the Court's opinion for finding patentable subject matter in the Martin plug, the Court below said:" (Emphasis ours.)
>
> > "'In other words, he produces the same result in a more efficient and facile manner by making *three* of those old elements accomplish the same result as *five* or more had theretofore done.'"

This remarkable accomplishment in a crowded art is not the *only* basis for finding patentable subject matter in the Martin plug. The Court also compared the claims carefully with the prior art to determine whether said claims

were anticipated and having concluded that they were *not anticipated,* the Court then considered whether the structure of these claims involved invention as distinguished from mechanical skill. The Court ruled in substance that the Defendant had failed to overcome, by the prior art patents relied on, the burden of showing clearly that the same invention was disclosed in said patents. This conclusion obviously is the "major" basis of the opinion, *i. e.,* that the Martin claims in issue do *not* read on the prior art, and hence are not anticipated.

In substantiation of our statements we quote from the opinion, the first paragraph on page 4, in which the position taken by the defendants is concisely stated by the Court as follows:

> "Defendants first contend that the general combination, which Martin claims, was old in the art;"
> (second) "that he disclosed no new result or new coaction of the elements, and hence there was no invention in substituting any particular elements in that old combination."

The Court then stated that the defendants were in error—

> "In this we think defendants are in error, and we think the error in this respect lies in the assumption that the general combination of Martin was old in the art, and that there was no new coaction of the elements used."

No legitimate conflict can be found in this decision in the Seventh Circuit Court of Appeals, as contrasted with opinions of the Supreme Court in the cases cited near the top of page 18 of Petitioner's brief.

## V.

REPLY TO POINT 4 OF PETITIONER'S BRIEF.

Petitioner's fourth point, on page 18 of its brief, alleges that the Martin claims are unpatentable aggregations, whereby the Court of Appeals' decision is in conflict with Supreme Court cases such as *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 549.

This identical allegation was before the Seventh Circuit Court of Appeals and was disposed of on page 5 of its opinion (R. 678) as follows:

> "In support of their contention, the defendants rely on *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545. That case held that the mere aggregation of a number of old elements which in the aggregation, perform no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. Obviously, that patent contained all of the elements of a prior art device, while in the Martin patent there are two or more elements in every prior art case cited which are not present in Martin, and the limited number of elements in his combination do coact in an inventively new manner."

### Conclusion.

The alleged errors relied on by Petitioner have been analyzed herein to show that there is no real basis therefor in the opinion of the Court of Appeals. Furthermore, even if errors of fact did appear in said opinion, it would afford no ground for the grant of a writ of certiorari by the Supreme Court in the absence of a definite conflict of decisions.

The Martin patent in suit below, and its validity, are matters of purely private interest rather than of public interest or importance, within the meaning of those terms

as employed in decisions construing or applicable to Rule 38 of the rules of this Court.

It is submitted, therefore, that the Petition should be denied.

Respectfully submitted,

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